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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,584	06/09/2000	Peter T Dietz	55434USA1A.002	2946

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EXAMINER

VO, HAI

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 07/16/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/591,584

Applicant(s)

DIETZ, PETER T

Examiner

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22, 24-28, 31-40 is/are rejected.
- 7) ☒ Claim(s) 23, 29 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8, 13-18, 24-28, 31,32, 34, 36, 38 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 24 recite the limitation "the hard coating" in line 11. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 7-11, 13, 17-21, 24, 26, 31-34, 36-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Hutchison (US 5,118,540). The combination of examples 5, 7 and 8 of Hutchison discloses the laminate having a thickness greater than 5 mils meeting the specific range required by the claims. Hutchison teaches a layer of silver is characterized by the presence of a spectral window through which ultraviolet light in the 200 to 400 nanometer region passes. The transmission of this light peaks at 325 nm (column 2, lines 15-20). Likewise, it is clearly apparent that the laminate of Hutchison exhibits ultraviolet

light transmittance. Further, the examiner believes that the presence of the thin silver layer in the laminate does not necessarily cause the laminate completely non-transmissive to visible light but rather to reduce the visible light transmittance of the laminate. Finally, since nothing in the claims is specific about the visible light transmittance of the laminate, Hutchison reads on the claimed subject matter. It is the examiner's position that Hutchison anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hutchison et al (US 5,118,540) as applied to claim 1 above, in view of Bilkadi et al (US 5,677,050) substantially as set forth in Paper no. 12.
7. Claims 14, 15, 22, 23, 25, 27, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hutchison et al (US 5,118,540) in view of Yang et al (US 6,013,722) substantially as set forth in Paper no. 12.
8. Claims 24-27, 34 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubler et al (US 6,143,387) in view of Yang et al (US 6,013,722) substantially as set forth in Paper no. 12.

Allowable Subject Matter

9. Claims 16 and 28 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
10. Claims 23, 29 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the prior art discloses or suggests a laminate having a recited structure defined in either claim 1 or 9 wherein the laminate comprises an optically clear laminate. None of the prior art discloses or suggests a laminate having a recited structure defined in either claim 1 or 9 wherein once attached to window glass has a percent visible light transmission greater than or equal to about 88.6%.

Response to Arguments

11. The 102 art rejections over Kubler have been overcome by the present amendment and arguments (the second paragraph of page 7 of Paper no. 13).
12. The 103 art rejections over Kubler with respect to claim 6, 9-11, 14, 16, and 18-23 have been overcome by the present amendment and arguments (the second paragraph of page 7 of Paper no. 13).
13. The art rejections over Hutchison are maintained because of the following reasons. The arguments that the laminate of Hutchison does not exhibit a light transmittance are not found persuasive. Hutchison teaches a layer of silver is characterized by the presence of a spectral window through which ultraviolet light in the 200 to 400 nanometer region passes. The transmission of this light peaks

at 325 nm (column 2, lines 15-20). Likewise, it is clearly apparent that the laminate of Hutchison exhibits 100% ultraviolet light transmittance. Further, Hutchison teaches a layer of silver being at least partially reflective to at least a portion of the visible between 300 to 2500 nm (claim 1). This suggests that the presence of the thin silver layer does not necessarily cause the laminate completely non-transmissive to visible light but rather to reduce the visible light transmittance of the laminate. Finally, since nothing in the claims is specific about a percent visible light transmission of the laminate, Hutchison reads on the claimed subject matter.

The arguments that Hutchison does not teach or suggest a laminate comprising first, second and third polyester film layers in combination with a scratch-resistant layer with respect to claim 12 are not found persuasive. Example 5 shows a laminate having a construction in a following order: Polyester/polyester/adhesive/silver/adhesive/polyester. Example 7 shows a laminate having a construction in a following order: Surface of solar energy /Adhesive/Polyester/polyester/adhesive/silver/adhesive/polyester. Example 8 shows a laminate having a construction in a following order: Surface of solar energy/adhesive/**Polyester/polyester**/adhesive/silver/adhesive/**polyester**/premask film. Hutchison does teach a laminate having three polyester layers in combination with a premask film.

The arguments that neither Kubler nor Yang discloses or teaches pressure sensitive adhesives having a shear storage modulus measured at 22

oC in the range of about 0.2 MPa to 0.5MPa are not found persuasive. It appears that Kubler and Applicants are using an acrylic pressure sensitive adhesive as an adhesive material of the laminate (Kubler, column 6, lines 63 vs. Applicants specification, page 10, lines 13-15). It is not be seen that the adhesive material of Kubler would have possessed a shear storage modulus measured at 22 oC outside the range set out in the claim. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990). Products of identical chemical composition can not have mutually exclusive properties.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Art Unit: 1771

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
July 12, 2003


TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700